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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,088	11/20/2003	Scott Robert Hinkelman	AUS920030897US1	9422
46073	7590	12/23/2008	EXAMINER	
IBM CORPORATION (VE) C/O VOLEL EMILE P. O. BOX 162485 AUSTIN, TX 78716			NGUYEN, THUY-VI THI	
			ART UNIT	PAPER NUMBER
			3689	
			MAIL DATE	DELIVERY MODE
			12/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/718,088	Applicant(s) HINKELMAN, SCOTT ROBERT	
	Examiner THUY VI NGUYEN	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on September 22, 2008, wherein:

Claims 1-20 have been amended;

Claims 1-20 are currently pending;

Claim Status

Independent claim 16 is amended as followed: (09/22/08).

Currently amended: A system for determining compliance of a received document with data content conformance standards receiving a document ~~by a party, the party having a set of policies, the system~~ comprising:

- a) at least one storage device for storing code data; and
- b) at least one processor for processing the code data to receive the document, to automatically-determine whether the document contains at least one standardized specification-conformance statement that identifies the received document as complying with a standardized specification that specifies data content requirements for documents containing the conformance statement, and wherein the conformance statement is associated with a corresponding conformance model that identifies the data content requirements of the standardized specification, and ~~to automatically verify, if the document contains the at least one standardized specification conformance statement, that information relating to the statement is conformant to the standardized~~

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~~specification as well as to the set of policies of the party~~ responsive to the received document containing the at least one conformance statement, to read the conformance model to determine whether the received document complies with the standardized specification.

Note that it appears that independent claim 16 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "for processing the code data.....with the standardized specification" carries no patentable weight.

Therefore, the claim is read as follow:

- a) at least one storage device for storing code data; and
- b) at least one processor

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-5 are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims **1-5**, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. The process steps of “*receiving....; determining....; reading....*”; is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

Claims 11-15 are rejected under 35 U.S.C. 101 because the claims deal with a system containing software and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition. The system claims appear to be an apparatus claim in a preamble “*An apparatus for determining...*”, however, there are no structures or functional elements which are required in an

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apparatus claim. For instant, the independent 11 recited “*means for receiving...., means for determining...., means for reading.....*” all appear to be software. Therefore, the claims are directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 second step recites “*wherein the conformance statement is associated with a corresponding conformance model that identifies the data content requirements of the standardized specification*” is vague and indefinite. It is not clear what is the “model” is whether it’s a tool, software module or merely a format or a pattern?

In claim 1, with the last step calls for “reading the conformance model to determine whether....”, it’s not clear whether just “reading” or “transferring data” on the “conformance model” alone can achieve the scope of the claim of “determining compliance of a received document”?

In claim 11, claim element “means for receiving, means for determining....” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material,

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or acts for the claimed function. Applicant's specification appears to disclose "a means of communication", but not the "means for receiving... and means for determining...." as stated in claim above. Therefore, applicant is required to

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP 2151 and 608.01(0).

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by MARLATT ET AL (US 7,146,422).

As for claim 16-20, which deals with the system for determining compliance of a received document with data content conformance standards comprising at least one storage device for storing code data, and at least one processor, see MARLATT ET AL, figure 1

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over MARLATT ET AL (US 7,146,422).

As for independent claim 1, MARLATT ET AL disclose a method of determining compliance of a received document with data content conformance standards comprising:

a) receiving the document

{see figures 1-2; col. 3, lines 63-67, col. 4, lines 1-25; “ *receiving information or data related to purchase order, business transaction*”};

b) determining whether the document contains at least one conformance statement that identifies the received document as complying with a standardized specification that specifies data content requirements for documents containing the conformance statement

{see at least figures 2-3, col. 1, lines 46-62, col. 3, lines 47-62, col. 4, lines 43-61”...*document must conform to be valid...*”, MARLATT ET AL discloses the verification or validation or determination whether the document or message contains at least one conformance statement or criteria or parameters, e.g. *document must be checked to ensure it meet the basic syntax and standard format of XML, e.g. determine whether the document is “well formed”, determine if the structure or grammar required by the particular XML document complies with structure or grammar required by the particular XML base language*}

and wherein the conformance statement is associated with a corresponding conformance model that identifies the data content requirements of the standardized specification {see figure 2; col. 5, lines 22-40, for the validation template/model using to validate the document}

c) responsive to the received document containing the at least one conformance statement, reading the conformance model to determine whether the received document complies with the standardized specification

{see figures 2-4, col. 4, lines 43-61; col. 6, lines 42-65, MARLATT ET AL discloses the obtaining the validation template/model in (step 315 figure 3) for validating the document whether the document is "well formed", and to determine if the structure or grammar of the document complies with structure or grammar required by the particular XML based language}.

Note that the term "compliance" appears to read over "conformance" in view of col. 4, lines 55-67. Alternatively, since both of these terms deal with "verification/validation" to a standard or an agreement, it would have been obvious to use the term "compliance" in view of "conformance" as mere using other similar or equivalent term for similar results. Therefore, MARLATT ET AL disclose all the claim invention as stated above, except for using the feature conformance (compliance) "model" feature in the last two steps. However, the feature "model" reads over pattern or format or template format. Note that MARLATT ET AL teaches the use of a "validation template" as a pattern or tool for validating a complied document against a template, see col. 1, lines 50-70. Therefore, in view of the teachings above, it would have been obvious to modify the feature conformance (compliance) template" of MARLATT ET AL with a model as merely using other similar or equivalent tool/format/pattern to achieve similar "validation" result.

Note: for convenience, letters (a)-(c) are added to the beginning of each step.

As for claim 2, which deals with the determining whether there is a specific sequence in which conformance statement or criteria have to be listed in the document if the document contains more than the at least one conformance statement or criteria or parameter, this is fairly taught in MARLATT ET AL {see col. 3, lines 47-63 and figures 2-3, disclose the listing of the document to determine the complying with the format or XML standard}

As for claim 3, which deals with wherein when the document contains more than the at least one conformance statement or criteria, it is determined whether each conformance statement or criteria is valid, this is fairly taught in MARLATT ET AL {see figures 2-3, and at least col. 5, lines 35-67, col. 6, lines 20-24}

As for claim 4, which deals with the condition if each conformance statement is not valid, an error statement is generated and returned, this is fairly taught in MARLATT ET AL, see figures 2-4, col. 8, lines 58-67, col. 9, lines 1-3 *"the invalid message can be blocked or not forwarded to server, send a message to the sender that the message or document is invalid"*}

As for claim 5, which deals with the notification message or an error statement is generated and returned if the conformance statements are not listed in the specific sequence, this if fairly taught in MARLATT ET AL, see figures 2-4, col. 8, lines 58-67, col. 9, lines 1-3 *"the invalid message can be blocked or not forwarded to server, send a message to the sender that the message or document is invalid"*}

As for independent claim 6, which deals with a computer program product on a computer readable medium for determining compliance of a received document with

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data content conformance standards, basically this limitation has the same limitation as the independent claim 1 above. It is rejected for the same reason sets forth the rejected independent claim 1 above.

As for dep. claims 7-10, basically these dep. claims have the same limitation as dep. claims 2-5 above. They are rejected for the same reason sets forth the rejected dep. claims 2-5 above.

As for independent claim 11, which deals with a system for determining compliance of a received document with data content conformance standards, basically this limitation has the same limitation as the independent claim 1 above. It is rejected for the same reason sets forth the rejected independent claim 1 above.

As for dep. claims 12-15, basically these dep. claims have the same limitation as dep. claims 2-5 above. They are rejected for the same reason sets forth the rejected dep. claims 2-5 above.

As for independent claim 16, which deals with the system for determining compliance of a received document with data content conformance standards comprising at least one storage device for storing code data, and at least one processor, see MARLATT ET AL, figure 1. Furthermore, the intended used limitation has the same limitation as the independent claim 1 above. It is rejected for the same reason sets forth the rejected independent claim 1 above.

As for dep. claims 17-20, basically these dep. claims have the same limitation as dep. claims 2-5 above. They are rejected for the same reason sets forth the rejected dep. claims 2-5 above.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information As for the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

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